

No. 16858

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JAYBEE MANUFACTURING CORPORATION,

Appellant,

vs.

AJAX HARDWARE MANUFACTURING CORPORATION,

Appellee.

APPELLEE'S BRIEF.

THOMAS P. MAHONEY,
4055 Wilshire Boulevard,
Los Angeles 5, California,
Attorney for Appellee.

FILED

AUG 30 1960

FRANK H. SCHMID, CLERK

TOPICAL INDEX

	PAGE
Summary of argument.....	1
Argument	3
I.	
The patent in suit is valid.....	3
A. The presumption of validity of the patent in suit has not been overcome by appellant.....	3
B. The District Court had before it adequate evidence to support the holding of validity.....	6
C. The slavish imitation of the design of the patent by appellant is indicative of the advance made by appellee	6
D. The design of the patent is new, original and ornamental	7
II.	
The District Court erred in holding that the patent was not infringed	8
A. The question of infringement of the patent by the accused device is before this court.....	8
B. The question of infringement is a question of law....	8
C. The addition of a modifying feature to the infringing device does not avoid infringement.....	9
D. Plaintiff's infringement was of a most flagrant nature	11
III.	
The District Court's refusal to grant relief under appellant's counterclaim for declaratory relief was well founded	12
Conclusion	14

TABLE OF AUTHORITIES CITED

CASES	PAGE
Electrolux Corp. v. Val-Worth Inc., 123 USPQ 175.....	13
Gorham Company v. White, 14 Wall. 511.....	11
Graham v. Cockshutt Farm Equipment, 256 F. 2d 358.....	8
Guiberson Corp. v. Equipment Engineers, 252 F. 2d 431.....	8
Jacuzzi Bros. v. Berkeley Pump Co., 191 F. 2d 632, 91 USPQ 24	5
Jonus v. Roberti, 7 F. 2d 563.....	10
Kurtz v. Belle Hat Lining Co., 280 Fed. 277.....	6
Kwikset Locks v. Hillgren, 210 F. 2d 483.....	8
Laskowitz v. Marie Designers, Inc., 119 Fed. Supp. 541.....	7
Long v. Dick, 38 Fed. Supp. 214.....	10
Marchus v. Druge, 136 F. 2d 602.....	8
Modern Products Supply Co. v. Drachenberg, 152 F. 2d 203, 68 USPQ 10.....	6
Otto v. Koppers Co., Inc., 114 USPQ 188.....	7
Robert W. Brown & Co., Inc. v. De Bell, 113 USPQ 172....	7
Solex Laboratories v. Graham, 165 Fed. Supp. 428.....	10

No. 16858

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JAYBEE MANUFACTURING CORPORATION,

Appellant,

vs.

AJAX HARDWARE MANUFACTURING CORPORATION,

Appellee.

APPELLEE'S BRIEF.

Summary of Argument.

I. THE PATENT IN SUIT IS VALID.

A. The presumption of validity of the patent in suit has not been overcome by Appellant.

B. The District Court had before it adequate evidence to support the holding of validity.

C. The slavish imitation of the design of the patent by Appellant is indicative of the advance made by Appellee.

D. The design of the patent is new, original and ornamental.

II. THE DISTRICT COURT ERRED IN HOLDING THAT THE PATENT WAS NOT INFRINGED.

A. The question of infringement of the patent by the accused device is before this Court.

B. The question of infringement is a question of law.

C. The addition of a modifying feature to the infringing device does not avoid infringement.

D. Plaintiff's infringement was of a most flagrant nature.

III. THE DISTRICT COURT'S REFUSAL TO GRANT RELIEF UNDER APPELLANT'S COUNTERCLAIM FOR DECLARATORY RELIEF WAS WELL FOUNDED.

ARGUMENT.

I.

The Patent in Suit Is Valid.

A. The Presumption of Validity of the Patent in Suit Has Not Been Overcome by Appellant.

Not a single one of the references applied by the Examiner during the prosecution of the application which issued as United States Design Letters Patent No. 182,602, Exhibit 1 [R. 46], was anticipatory of the basic concept of Appellee's assignor.

During the prosecution of the patent in issue, the Examiner applied two references, namely, United States Design Letters Patent No. 169,257, Exhibit 5 [R. 46], and United States Design Letters Patent No. 180,684, Exhibit 6 [R. 49].

Design Patent No. 169,257, Exhibit 5, discloses a pull which is:

- (1) Made of bar material;
- (2) Concave in transverse cross section;
- (3) Substantially rectangular in edge elevation, Figure 4;
- (4) Provided with a downward arch at its extremities.

The design of the pull of Design Patent No. 180,684, Exhibit 6, is more pertinent to Appellee's design concept than the prior art relied upon by Appellant, because this design:

- (1) Is substantially rectangular;
- (2) Has a pronounced upward arch;

- (3) Has an elongated central opening;
- (4) Has mounting studs adjacent its extremities.

Appellant has assumed that various exhibits, namely Exhibit E-3, Exhibit H and Exhibit C (Appendices 1-3 to Appellant's Br.), which were not cited by the Examiner during the prosecution of the application from which the patent in suit issued, have destroyed the customary presumption of validity afforded an issued patent by the Courts.

A comparison of the prior art cited by the Examiner with that relied upon by Appellant is conducive to the belief that none of the prior art relied upon by Appellant is as pertinent as that cited by the Examiner. The pull of Exhibit E-3:

- (1) Is predominantly rectangular;
- (2) Presents a massive aspect;
- (3) Incorporates no opening;
- (4) Is of uniform width from one extremity to the other thereof;
- (5) Has an arcuate top and bottom.

The pull, Exhibit H:

- (1) Is substantially ellipsoidal;
- (2) Is of exaggerated length;
- (3) Lacks the central opening;
- (4) Does not incorporate the contrast of the ellipsoidal opening with the substantially bowed rectangle of Appellee's design;
- (5) Has an arcuate top and bottom.

Exhibit C can add nothing to Exhibits E-3 and H other than the provision of a pair of substantially rectangular openings separated by an intermediate bridge.

It is self-evident from the physical exhibits themselves and from the analysis of the drawings thereof attached as Appendices 1-3 to Appellant's Brief, that none of the designs of Exhibits E-3, H and C is as pertinent as the prior art cited by the Examiner during the prosecution of the application from which the patent in issue matured. It is well established law that the presumption of validity afforded a patent by the Courts is overcome only when art more pertinent than that applied by the Examiner is submitted by the defendant as a basis for invalidation of the patent.

In *Jacuzzi Bros. v. Berkeley Pump Co.* (1951), 191 F. 2d 632, 91 U. S. P. Q. 24, 27, this Court said:

“But further, a great many of the patents, which were brought to light in this lawsuit and considered by the Trial Court, had not been previously considered by the Patent Office. *Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here.*”

The analysis hereinabove of the prior art relied upon by Appellant is indicative of the fact that it is actually less pertinent than that cited by the Examiner and thus, in accordance with the decision cited, does not destroy the presumption of validity afforded the patent in issue.

B. The District Court Had Before It Adequate Evidence to Support the Holding of Validity.

All of the prior art relied upon by Appellant in support of its contention of invalidity of the patent in issue was before the District Court and was considered in conjunction with the testimony of witnesses of Appellant pertinent thereto. It is submitted that the judgment of validity of the patent in issue is well founded on the evidence before the District Court and that there was no clear error which would warrant the reversal of the holding of the District Court in this regard.

“It is established, of course, that in a patent case the findings of fact of the district court—unless clearly erroneous—should not be disturbed.” *Modern Products Supply Co. v. Drachenberg*, 152 F. 2d 203, 207, 68 U. S. P. Q. 10, 14 (C. A. 6).

C. The Slavish Imitation of the Design of the Patent by Appellant Is Indicative of the Advance Made by Appellee.

It has been repeatedly held that a defendant's imitation of a patented device or structure can be taken as evidence of invention as stated by Judge Hough in *Kurtz v. Belle Hat Lining Co.* (2 Cir.), 280 Fed. 277, 281:

“The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.”

See also:

Otto v. Koppers Co. Inc. (C. A. 4, 1957), 114 U. S. P. Q. 188;

Robert W. Brown & Co., Inc. v. DeBell (C. A. 9, 1957), 113 U. S. P. Q. 172.

A visual comparison of the alleged infringing pull manufactured by Appellant with the pull shown in the patent in issue and the pull manufactured by Appellee in accordance with said patent is illustrative of two facts:

(1) That Appellant's only design source was the pull of Appellee's design; and

(2) Appellant copied Appellee's design in a most slavish and non-creative manner.

D. The Design of the Patent Is New, Original and Ornamental.

The analysis of the prior art cited by the Patent Office and the prior art relied upon by Appellant in attempting to overcome the presumption of validity and invalidate the patent in issue is illustrative of the fact that the design of the patent in issue was new, novel and ornamental and constituted an inventive contribution by Appellee's assignor.

As stated by Judge Yankwich in *Laskowitz v. Marie Designer, Inc.* (D. C. S. D. Cal.), 119 Fed. Supp. 541, 544:

“Patentability exists if the design looked at as a whole (*le tout ensemble*) gives a pleasing impression. Of course, the result must come from the exercise of the inventive faculty. If these elements are present it is not material that the design may embody a regrouping of familiar forms and decoration.”

II.

The District Court Erred in Holding That the Patent Was Not Infringed.

A. The Question of Infringement of the Patent by the Accused Device Is Before This Court.

In numerous cases it has been held that an appeal from the decision of the Lower Court brings the entire record before the Appellate Court. In *Guiberson Corp. v. Equipment Engineers*, 252 F. 2d 431, 432 (5 Cir. 1958), considering whether the question of validity of a patent was before it, the Appellate Court held as follows:

“We, however, agree that the question of the validity of the patent is before us not because of the so-called cross appeal but because plaintiff’s appeal from the decision dismissing its suit brought the whole record up and all questions going to the correctness of the judgment are properly before us.”

See also:

Marchus v. Druge, 136 F. 2d 602 (9 Cir. 1943);
Graham v. Cockshutt Farm Equipment, 256 F. 2d 358, 359 (5 Cir. 1958).

B. The Question of Infringement Is a Question of Law.

It has been held in this circuit that where there is no dispute as to the evidentiary facts, and the record and exhibits are clear, the question of infringement resolves itself into a question of law.

Kwikset Locks v. Hillgren, 210 F. 2d 483 (9 Cir. 1954).

Therefore, this Court may determine whether the judgment of the District Court that no infringement of

the patent in issue had occurred was well founded. The issue of non-infringement is susceptible to *de novo* re-examination by this Court, since the entire record and all elements of the judgment of the Lower Court are subject to re-evaluation by this Court.

C. The Addition of a Modifying Feature to the Infringing Device Does Not Avoid Infringement.

A simple comparison of the device of the design of the patent in issue with the design of the alleged infringing pull should be sufficient to convince this Court that the Lower Court was clearly in error in its holding of non-infringement. Since the Lower Court held the patent in suit valid it is submitted that, on the evidence before it, it should have held the patent infringed. A consideration of the common design elements of the design of the patent in issue and the design of the alleged infringing device incontrovertibly establishes identity of the two designs, as follows:

(1) Both the design of the patent and the design of the alleged infringing device are constituted by elongated bodies with substantially square ends and bowed-out sides;

(2) Both bodies have dished or concave upper surfaces;

(3) Both bodies incorporate centrally located, substantially ellipsoidal openings which terminate inwardly of the mounting bosses for the bodies;

(4) Both bodies have downwardly curving bottom portions;

(5) The top edges of both bodies are straight.

In addition to incorporating every design element of the patent in issue, the alleged infringing device has had a pair of semi-circular cross bars incorporated therein intermediate the extremities of the elongated opening in the body. Appellant has evidently attempted, by the incorporation of this modification, to avoid the onus of a charge of infringement. However, it has been repeatedly held that the addition of an element or improvement to an infringing device will not avoid a charge of infringement if the exclusive features of the patent in suit have been adopted.

In *Jonus v. Roberti*, 7 F. 2d 563 (9 Cir. 1925), this Court held as follows:

“But an inventor cannot be deprived of the benefit of the idea which he has disclosed to the public by improvements subsequently made by another in carrying forward the art.”

Similarly, in *Long v. Dick*, 38 Fed. Supp. 214, 219 (D. C., S. D. Cal. C. D. 1941), the Court considered the same problem in the following language:

“An addition which results in no substantial change of character merely for the purpose of avoiding the patent does not avoid infringement.”

See also:

Solex Laboratories v. Graham, 165 Fed. Supp. 428 (D. C. S. D. Cal.).

D. Plaintiff's Infringement Was of a Most Flagrant Nature.

Even the most superficial comparison of the alleged infringing device with the drawings of the patent in suit and with the actual embodiment of the design of the patent in suit manufactured by Appellee should be sufficient to convince this Court that the design of the patent in suit has been willfully appropriated by the Appellant. As a matter of fact, the pull manufactured by Appellant and the pull manufactured by Appellee are of identical dimensions and configuration.

The criterion of infringement of a design patent is whether the similarity between the design of the patent in suit and the design of the alleged infringing device is such as to confuse the eye of the casual purchaser and to lead said purchaser into thinking that the infringing device is the device of the patent in suit. This test was clearly stated by the Supreme Court of the United States in *Gorham Company v. White*, 14 Wall. 511, in the following language:

“Plainly, it must be the sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or lesser number of lines, or slight variations in configuration . . . will not destroy the substantial identity.”

III.

The District Court's Refusal to Grant Relief Under Appellant's Counterclaim for Declaratory Relief Was Well Founded.

Appellant is not entitled to a prospective injunction. The burden of Appellant's argument relating to the refusal of the Lower Court to grant an injunction under Appellant's counterclaim is to the effect that the Appellee should be restrained from asserting that the patent in issue is or ever was infringed by Appellant or its customers.

It is manifestly not the function of injunctive relief to restrain an action which has not been threatened. That is, there is no evidence in the record to indicate that Appellee intends to charge Appellant with the infringement of the patent in suit because of the manufacture of the alleged infringing pulls.

If Appellee were to charge Appellant with infringement of the patent in issue because of the manufacture of the pulls which the Lower Court held would not constitute infringement, then the Appellant would have an appropriate basis for seeking the jurisdiction of the Court and requesting injunctive relief. However, in the absence of a threat of such charges of infringement, the issuance of an injunction by the Lower Court would constitute an attempt to forestall an action which has not even been threatened. The mere fact that, prior to the adjudication of the patent in issue, Appellee charged Appellant and its customers with infringement in two letters, does not establish a tendency or intent upon the

part of Appellee to assert infringement of the patent in suit against pulls manufactured by Appellant which have been held not to infringe the patent in suit.

The undesirability of injunctive relief of a prospective nature in the absence of an imminent threat of harm was considered by the New York Court of Appeals in *Electrolux Corp. v. Val-Worth Inc.*, 123 U. S. P. Q. 175, 179. in the following language:

“The second question results from the use of the word ‘famous’ in the telecasts prior to January 12, 1953. Even if we assume that both courts deemed it misleading, we observe that there is no question but that this practice was discontinued on television after protest by plaintiff about six months prior to the commencement of the action. The Appellate Division took the view that this discontinuance six months prior to the commencement of the action and the absence of any indication in the record that defendants intend to resume the practice render an injunction unnecessary and inappropriate. We are in accord with this result, for the extraordinary relief of an injunction is protection for the future and is not proper unless the injury is imminent.
. . . .”

There is no proof in the record that, after the letters written in April, 1959. Exhibits N-1 and N-2 [R. 51-52], the Appellee has ever threatened the Appellant or its customers in any way because of the manufacture of the alleged infringing device. Therefore, the issuance of an injunction against the Appellee would appear

to be a nugatory act in the absence of an imminent threat that the Appellee intended to charge infringement of its patent by Appellant or its customers.

Conclusion.

It is respectfully submitted that the District Court properly held that the patent in issue is valid and that no relief should be granted to Appellant in injunctive form against charges of infringement made by Appellee against Appellant or its customers.

However, since the Lower Court held the patent in issue valid, its decision that the alleged infringing device did not infringe the patent in suit was clearly erroneous and subject to reversal by this Court. The prior art upon which the Appellant relies in an attempt to overcome the presumption of validity afforded the patent is completely inadequate and no more pertinent than the file wrapper art applied during the prosecution of the application which resulted in the patent in issue.

Therefore, it is respectfully submitted that the judgment of the District Court should be sustained on the issue of validity and reversed on the holding of non-infringement of the patent in suit.

Respectfully submitted,

THOMAS P. MAHONEY,

Attorney for Appellee.